

REMARKS

Claims 1-16 are pending in the present case. Claim 1 is the only independent claim.

By this amendment, claim 6 is amended for clarity.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Allowable Subject Matter

Please note that the Examiner has only rejected claims 6-8 under 35 U.S.C. §112, 2nd paragraph. As such, it stands to follow that claims 6-8 are allowable, but for the 112 rejections.

The Claims Satisfy The Requirements Of 35 U.S.C. §112, 2nd Paragraph

The Office Action reject claims 6-8 under 35 U.S.C. §112, 2nd paragraph. This rejection is respectfully traversed.

Applicant respectfully submits that the amendment to claim 6 obviates the rejection of claims 6-8 under 35 U.S.C. §112, 2nd paragraph.

Accordingly, withdrawal of the rejection of claim 6-8 under 35 U.S.C. §112, 2nd paragraph is respectfully solicited.

The Claims Define Patentable Subject Matter

The Office Action makes the following rejections:

(1) Claims 1-5 and 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent No. 11127211 A to Matsuura (hereafter Matsuura) in view of U.S. Patent No. 5,155,453 to Ruetz (hereafter Ruetz); and

(2) claims 9-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuura in view of Ruetz and further in view of Publication No. 2004/0166799 to Kral (hereafter Kral).

These rejections are respectfully traversed.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of Matsuura and Ruetz for at least the following reasons:

The Examiner alleges that Matsuura discloses a cable modem tuner comprising a down converter circuit (47 and 58) for selectively outputting an intermediate frequency signal of the first frequency band (output 15) or a second frequency band lower than said first frequency band (output 35). (see Office Action, page 4, 1st paragraph.) Applicant disagrees with this allegation.

It appears that the Examiner is relying on a partial translation of paragraphs [0028], [0031], and [0032] of Matsuura. (see Office Action, page 4, 1st paragraph, last line). Such translations have not been supplied to Applicant. As such, our comments are mainly based on the English Abstract and Fig. 1 of Matsuura.

In reviewing Matsuura's Fig. 1, it appears that Matsuura fails to disclose selectively outputting an intermediate frequency of the first frequency band or a second frequency band lower than the first frequency band by utilizing the local oscillation circuit 50. The only selection circuits Matsuura discloses is the selection circuits 18 to 20 for selectively outputting *an input received signal to three systems according to a frequency band* (see Matsuura, Abstract).

In other words, Matsuura merely selects one of three systems according to a frequency band prior to any input to the alleged down converter circuit (47 and 58).

Furthermore, the Examiner concedes that Matsuura fails to disclose a local oscillating circuit for generating an oscillation signal corresponding to the second frequency band in a first mode..., stopping generation of the oscillation signal in a second mode, as set forth in claim 1. (see Office Action, page 4, 2nd paragraph). In other words, Matsuura fails to utilize the oscillation circuit 50 for selectively outputting an intermediate frequency.

In an attempt to make up for the deficiencies found in Matsuura, the Examiner imports Ruetz. Specifically, the Examiner alleges that Ruetz discloses an oscillator means with dual output modes, that is controlled by an external control means, such that the oscillator generates an oscillating output signal in a first, "normal", mode of operation and stops generating an oscillating output signal in a second "sleep" mode. (see Office Action, pages 4-5). The

Examiner further alleges that it would have been obvious to modify the down converter means of Matsuura by using a dual-mode oscillator as taught by Ruetz... thereby allowing circuit 47 to be integral to circuit 58 Matsuura. Applicant disagrees with these allegations.

For example, applicant submits that Ruetz merely discloses a power saving sleep mode for reducing power consumption. As such, in Ruetz, when the sleep mode (first mode) is being used the output circuit is disabled, because no output oscillation signal having a required electrical characteristic is being outputted. Furthermore, in Ruetz, in the normal mode (second mode), the oscillation signal is supplied adequately. However, Ruetz fails to disclose that its oscillator generates an oscillation signal corresponding to a second frequency band which is lower than the first frequency band. Applicant submits that both Matsuura and Ruetz fail to disclose a signal corresponding to the second frequency band as claimed in the present invention.

The Examiner alleges that circuit 47 of Matsuura could be integral with circuit 58 of Matsuura if the dual-mode oscillator of Ruetz was added to Matsuura. Applicant disagrees with this allegation.

Neither Matsuura nor Ruetz discloses how or why one would add such a dual-mode oscillator to the configuration of Matsuura and how circuit 47 would be modified accordingly. The Examiner is merely using improper hindsight in order to arrive at the claimed invention, without providing a proper motivation for making the combination. Applicant submits that neither Matsuura nor Ruetz discloses such a combination. If Matsuura discloses both a first frequency band output at terminal 15 and a second frequency band output at terminal 35 as alleged by the Examiner, then it goes to follow that Matsuura would not be motivated to add Ruetz's dual-mode oscillator.

Furthermore, it is uncertain to us whether Matsuura even discloses outputting a second frequency at output 35, as alleged by the Examiner. As mentioned above, the information available to us does not disclose such an output signal at output 35.

In any case, applicant submits that the Examiner is attempting the paste features from two different references together to arrive at the claimed invention, without providing a proper

motivation for doing the same and without showing whether such a modified configuration is even feasible.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the combination of cited references fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 1 is allowable over the cited art for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-5 and 9-16 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion


In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Carolyn T. Baumgardner (Reg. No. 41,345) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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